



Atty. Dkt. No. 024918-0123

JULY 29 2009
DAE
F

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yoshinori FUKUI et al.

Title: METHOD OF SCREENING A SUBSTANCE
INTERFERING IN THE ASSOCIATION OF
DOCK2 AND ELMO

Appl. No.: 10/535,223

International 11/14/2003
Filing Date:

371(c) Date: 03/27/2006

Patent No.: 7,541,153

Grant Date: 06/02/2009

Examiner: Cherie Michelle Woodward

Art Unit: 1647

Confirmation 9403
Number:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on June 2, 2009 as U.S. Patent No. 7,541,153.

The Patent Office determined that the patent was entitled to 325 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C.

§154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 697 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 698 days

(b) Total Applicant delay: 1 day

Final PTA Determination: 697 days

Applicants therefore respectfully request that the patent be accorded 697 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date July 29, 2009

By Michael D. Kaminski

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5490
Facsimile: (202) 672-5399

Michael D. Kaminski
Attorney for Applicant
Registration No. 32,904



Atty. Dkt. No. 024918-0123

Patent Term Adjustment Calculation System

Docket Number: 024918-0123

Application Number: 10/535223

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	11/26/2002	-912		
Edit Delete	International Filing Date	11/14/2003	-559		
Edit Delete	National Stage Transmittal (NOT all 371(c) Requirements Met)	05/17/2005	-9		
	PCT National Stage Commencement Date	05/26/2008	0		
Edit Delete	Notice of Missing Requirements	12/30/2005	218		
Edit Delete	Response to Notice of Missing Requirements	03/27/2006	305		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	03/27/2006	305		
	14 month From Application date	05/27/2007	731		
Edit Delete	Restriction Requirement	04/17/2008	1,057	326	
Edit Delete	Restriction Requirement Response Received at PTO	05/13/2008	1,083		
	3 Year Period Starts	05/26/2008	1,468		
Edit Delete	Non-Final Office Action	08/11/2008	1,173		
	Non-Final Office Action + 3 months	11/11/2008	1,265		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	11/12/2008	1,266		1
Edit Delete	Notice of Allowance	02/06/2009	1,352		
Edit Delete	Issue Fee Paid	04/20/2009	1,425		
Edit Delete	Patent Grant Date	06/02/2009	1,468	372	
Totals:				698	1
PTA:				697	

Created and maintained by

FOLEY

FOLEY & LARDNER LLP

Foley & Lardner LLP